

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOE G. NAYLOR, EDWARD R. PRINCE III and JOSH A. MAILMAN

Appeal No. 2006-0203
Application No. 09/187,332¹

ON BRIEF

Before KRASS, GROSS and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 19-36. Claims 1-18 have been canceled.

We affirm.

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¹ Application for patent filed November 6, 1998.

BACKGROUND

Appellants' invention is directed to simultaneous transmission of a fax and an electronic mail to an intended recipient by a fax machine. According to Appellant, transferring electronic mail and facsimiles is accomplished by a user who enters a facsimile telephone number and an electronic mail address corresponding to the same recipient. The recipient information is stored in a memory associated with an actuator which causes the transmission as initiated by the user activating a control button or switch (specification, page 5). An understanding of the invention can be derived from a reading of exemplary independent claim 19, which is reproduced below:

19. A method comprising:

receiving from a user a facsimile telephone number and an electronic mail address of the same recipient, and storing the number and address in a memory of a facsimile machine;

converting a document provided by the user to the facsimile machine into digital form;

associating an actuator disposed on the facsimile machine to locations in the memory which contain the facsimile telephone number and the electronic mail address; and

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transmitting the converted document to the facsimile telephone number and to the electronic mail address in response to the same instance of the actuator being activated by the user.

The Examiner relies on the following prior art references:

Ho et al. (Ho)	5,805,298	Sep. 8, 1998
Fabbio et al. (Fabbio)	5,870,089	Feb. 9, 1999
		(filed Nov. 24, 1997)

Claims 19-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ho and Fabbio.

We make reference to the answer (mailed June 16, 2004) for the Examiner's reasoning, and to the appeal brief (filed March 30, 2004) and the reply brief (filed August 19, 2004) for Appellants arguments thereagainst.

OPINION

Appellants argue that merely because Ho allows sending a document to one specific destination, either a remote facsimile or an e-mail address, it would not have been obvious to send it to both simultaneously (brief, page 6). Appellants further point out that relying on the software in the general purpose computer of Fabbio for delivering a document to both a facsimile and a printer would be a departure from the document transmission by a stand alone facsimile (brief, page 7). While conceding that

Fabbio identifies different destinations for sending a digital document, Appellants argue that there is nothing in the reference to suggest that these destinations be of the same recipient (id.). Additionally, Appellants point out that the combination is not reasonable since it requires replacing a public switched telephone network with the functionality of a server and its associated software (brief, page 8).

In response to Appellants' arguments, the Examiner argues that although Ho sends either a fax or an e-mail, it is Fabbio which teaches sending both at the same time (answer, page 6). The Examiner further points out that since Fabbio provides for the simple modification of sending a digitized document to more than one destination "at the same time," it would have been obvious to send the fax and the e-mail simultaneously to eliminate the need for multiple transmissions (id.). The Examiner further identifies the claim term "of the same recipient" as a limitation that has neither any functionality nor any structural impact on the process recited in claim 1 (id.).

The initial burden of establishing reasons for unpatentability rests on the Examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Examiner is expected to make the factual determination supported by teachings in a prior art reference or shown to be common knowledge of unquestionable demonstration, consistent with the holding in set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). When an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references. See In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). A motivation to combine prior art references may be found in the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). Also, evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

From our review of Ho and Fabbio, we remain unpersuaded by Appellants' arguments that any error in the Examiner's determination regarding the obviousness of the claimed subject matter has occurred. Both references are concerned with sending an electronic file to different destinations. Ho transmits the scanned document to either a fax machine or an e-mail account (col. 6, lines 24-27) if the destination is in the form of a telephone number or in the form of an electronic mail address, respectively (col. 7, lines 6-17). Fabbio, similarly sends a document to multiple destinations such as an e-mail address and a fax machine outside the network and a printer connected on the local area network (col. 3, lines 6-12). Although Fabbio does not specifically identify the destinations as an e-mail address and a fax machine belonging to the same recipient, such requirement, as argued by the Examiner, does not distinguish the claimed subject matter over the applied art. The common ownership of the destinations' addresses or numbers is a non-functional descriptive aspect of the claims that has no bearing on receiving the destination addresses and transmitting the document to those destinations. In other words, the same

functions need to be performed whether the destinations belong to the same recipient or different ones. Thus, as stated by the Examiner (answer, page 6), the advantages of creating an electronic package for sending a document to various types of destinations without having to run separate software applications, as described by Fabbio (col. 2, lines 2-12 & 34-37), would have motivated one of ordinary skill in the art to modify the system of Ho to accept multiple destinations information in order to send a document to those multiple destinations.

We also remain unconvinced by Appellants' argument (brief, page 8) that the delivery server 12 in Figure 2 of Fabbio may not be used in place of the PSTN 106 in Figure 1 of Ho. The combination does not require a substitution and instead takes the suggestion by Fabbio that a document may be sent to multiple destination addresses when such is available. For example, as shown in Figure 3 of Ho, a determination as to whether the destination address relates to a fax machine or an e-mail is performed which causes the appropriate channel of remote

connection be selected. However, as suggested by Fabbio, the document may be sent to multiple destinations, which merely requires that each of the destination addresses be identified as either a fax number or an e-mail address through the process depicted in Figure 3 of Ho. Therefore, as the Examiner has established a prima facie case of obviousness with respect to claim 19, we sustain the 35 U.S.C. § 103(a) rejection of claim 19, as well as claims 20, 21, 23, 26-28, 30-34 and 36, argued therewith as falling together (brief, pages 4-8) over Ho and Fabbio.

Turning now to the rejection of claim 22, we note Appellants' arguments with respect to the claimed server acting as an intermediary that allows the transmission of the e-mail and the fax message according to a single protocol (brief, page 9). The Examiner's response focuses on the use of a commercial service by Ho (col. 3, lines 58-61) which originates both the facsimile and the e-mail versions of the transmission (answer, page 6). Appellants assert that Ho merely refers to what a router is and not that a single protocol is used for

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transmitting the fax message and the e-mail (reply brief, pages 3-4).

We disagree with Appellants that the portions of Ho relied on by the Examiner do not teach the claimed networks for transmitting the fax and the e-mail messages. The PSTN 106 in Ho provides the necessary links for the facsimile communication as well as the electronic mail communications which, in turn, may be performed by a commercial service for access to the Internet (col. 3, lines 31-42 & 58-61). Although using a single protocol for such transmission is not specified by Ho, we do not find that the claims require such protocol either. In that regard, Ho uses a public switched telephone network (PSTN) for facsimile and e-mail transmission, whether a router or a commercial network is used. Therefore, as the Examiner has established a prima facie case of obviousness with respect to claim 22, we sustain the 35 U.S.C. § 103(a) rejection of claim 22, as well as claims 24, 25, 29 and 35 argued together with claim 22 (brief, pages 8-9), over Ho and Fabbio.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 19-36 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



ERROL A. KRASS)
Administrative Patent Judge)
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